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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,550	04/08/2004	Cherik Bulkes	141262NM	8385

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JOSEPH S. HEINO, ESQ.
111 E. KILBOURN AVENUE
SUITE 1400
MILWAUKEE, WI 53202

EXAMINER

SOLANKI, PARIKHA

ART UNIT	PAPER NUMBER
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3737

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/12/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/820,550

Applicant(s)

BULKES ET AL.

Examiner

Parikha Solanki

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 April 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>4/8/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the left and right RF coils of claims 9 and 15 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

2. Claim 1 objected to because of the following informalities: line 8 contains a typographical error. Examiner suggests that Applicant replace the word "aperture" with "apertures". Appropriate correction is required.

3. Claim 7 is objected to because it recites elements without proper antecedent basis. The terms "the lateral compression plate" and "the medial plate" are not recited in either of claims 5 or 6, from which claim 7 depends. In view of the specification and drawings, Examiner assumes that the lateral and medial compression plates of claim 7 are equivalent to the first and second compression plates, respectively, as recited in claim 5. Examiner will further examine claim 7 under this assumption for the remainder of this Office Action. Examiner suggests that Applicant

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amend one or both of these claims to correct the consistency of these terms so as to cure the lack of antecedent basis in claim 7. Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 10-12, 16 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Schneider et al (US Patent No. 5,855,554), previously made of record by Applicant.

Regarding claims 1, 10, 16 and 17, Schneider ('554) discloses a patient support system operable to localize a patient's breasts when the patient is in the prone position (Abstract, Fig. 2). The system of Schneider ('554) includes a concave upper layer 20, which is configured to slide into a recess in a lower layer 22 (Fig. 2). Specifically, Schneider ('554) states that the support system may be retrofitted to an existing medical imaging device table (col. 3 lines 30-32). The chest support of Schneider ('554), which is part of the upper layer, is angled upwardly relative to the lower layer. Schneider ('554) provides a pair of apertures through which a patient's breasts may be inserted for a medical procedure (Fig. 8). The system of Schneider ('554) includes wheels, as shown in Figure 2, thereby constituting a mobile patient transport apparatus.

Regarding claims 11 and 12, Schneider ('554) discloses a pair of compression plates for immobilizing each breast, wherein the plates are placed medially and laterally, and the plates are translated towards each other to achieve breast compression (col. 3 lines 52-54, col. 4 lines 11-14, Fig. 8).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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7. Claims 2-9 are rejected under 35 U.S.C. 103(a) as being obvious over Schneider ('554) in view of Coonrad (US Patent No. 5,014,375).

Regarding claims 2-6, Schneider ('554) substantially discloses the present invention as set forth above. Schneider ('554) additionally shows that the torso support of the patient support system is cantilevered out from the lower layer (Fig. 2). Schneider ('554) further teaches that a pair of MR coils may be located in the compression plates, the MR coils being equivalent to RF coils as claimed in the instant application (col. 4 lines 21-29). Schneider ('554) fails to include a leg support angled upwardly from the midsection of the upper layer. In the same problem-solving area, Coonrad ('375) teaches a leg supporting foam member 16 for use during surgical procedures, the foam member being upwardly angled from the patient table (Fig. 2). Such foam members are widely used in the art during various medical procedures as a means of increasing patient comfort. At the time of invention, it would have been obvious to one of ordinary skill in the art to use the patient support system of Schneider ('554) with the leg support of Coonrad ('375), to reduce patient discomfort during the medical procedure.

Regarding claims 7-8, Schneider ('554) and Coonrad ('375) teach all features of the invention of claim 6 as addressed above. Schneider ('554) teaches that the compression plates are capable of stabilizing the breast (col. 4 lines 11-15). Examiner contends that the plates of Schneider ('554) must then have a high enough coefficient of friction to grip the breast in order to achieve such stabilization, and as such this limitation is implicitly taught by Schneider ('554). Schneider ('554) further teaches that gravity is employed to pull the breast tissue away from the chest wall to make the breast more accessible for the medical procedure (col. 3 lines 41-44). It is known in the art that, during breast biopsy and imaging procedures, it is desirable to pull the breast away from the chest in order to better localize the breast tissue of interest. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to make the compression plates of Schneider ('554) translatable in the vertical direction in order to pull the breast away from the patient's chest, as rendering an element adjustable when a need for such has been established in the art is not considered a patentable advance (see MPEP 2144, section V, *In re Stevens* 212 F.2d 197, 101 USPQ 284 (CCPA 1954)).

8. Claims 13-15 and 18-20 are rejected under 35 U.S.C. 103(a) as being obvious over Schneider ('554). Schneider ('554) discloses all features of the invention of claims 11 and 16 as set forth above.

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The limitations of claims 13 and 19 are obvious over the Schneider system ('554) as applied to claim 7 above, and claims 14 and 20 are implicitly taught by Schneider ('554) as applied to claim 8 above.

Regarding claim 15, Schneider ('554) teaches a pair of RF coils as applied to claim 9 above.

Regarding claim 18, one of ordinary skill in the art at the time of invention would have considered it obvious to reduce the thickness of the patient support of Schneider ('554) near the breast apertures in order to expose a greater area of the breast during the medical procedure, as the problem of maximizing the accessibility of the breast during medical procedures is known in the art.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Parikha Solanki whose telephone number is 571.272.3248. The examiner can normally be reached on M-F, 8 - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on 571.272.4956. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Parikha Solanki
Examiner - Art Unit 3737



ELENI MANTIS MERCADER
SUPERVISORY PATENT EXAMINER